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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,156	04/16/2004	Marc C. Zeitoun	74622-060	7855

21890 7590 12/20/2005

PROSKAUER ROSE LLP
PATENT DEPARTMENT
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NEW YORK, NY 10036-8299

EXAMINER

KYLE, CHARLES R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/825,156	Applicant(s) ZEITOUN ET AL.	
	Examiner Charles Kyle	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-75 and 77-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-75 and 77-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 76 is objected to because of the following informalities: It is missing. Appropriate correction is required. The claims are treated as numbered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 51-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. They recite "Investor/Goal Manager" and "Profile/Asset" screens, the nature of which is unclear.

Claims 72-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. They recite a "Investor/Goal Manager" screen, the nature of which is unclear.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41-42, 45-46, 47-50, 62-63, 65, and 66-71 are rejected under 35 U.S.C. 103(a) as being anticipated by US 5,918,217 *Maggioncalda et al* in view of US 2003/0208427 *Peters et al*.

As to Claim 41, *Maggioncalda* discloses the invention substantially as claimed including in a system configured to output financial investment advice regarding investments in an investment portfolio (Abstract) associated with a designated goal based, at least, on an investor's risk and investment profile data information provided by a user (Col. 13, line 9 to Col. 14, line 47, particularly Col. 13, lines 59-64; Fig. 8), the system comprising:

a front-end (Col. 6, lines 25-29) including a plurality of graphical user interfaces configured to receive a user's identification of an investor's risk and investment profile data (Col. 10, line 31 to Col. 11, line 18; Figs. 4, 5b, 9, 12a and 12b);
and

a back-end (Col. 6, lines 25-29) configured to, at the direction of the user via the front-end, identify one or more recommended investments, and an allocation of funds among those investments (Col. 9, lines 29-62; Fig 4, ele. 430; Fig 13), based on the investor's risk and investment profile, a time horizon and a type of the designated goal). (Col. 13, line 9 to Col. 14, line 47, particularly Col. 13, lines 59-64; Fig. 8).

Maggiocalda does not specifically disclose the details of the new recited claim limitations. *Peters* discloses these limitations as follows:

the back end (paras. 64-67) identifies the investor and at least one investor account from the investment profile data (para. 25, "personalized investment advice"), wherein the back-end

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quantifies the designated goal from at least one response to at least one goal question presented to the user by the front-end (para. 26), wherein the back end quantifies the investor's risk tolerance from at least one response to at least one risk tolerance question presented to the user by the front-end (para. 26), wherein the back-end creates a risk allocation of the at least one investor account among a plurality of investments that satisfies the investor's risk tolerance (para. 28), and wherein the front-end displays on a graphical user interface (paras. 25-28) a current allocation of the at least one investor account among the plurality of investments (Fig. 18, ele. 1810; para. 94), the risk allocation of the at least one investor account among the plurality of investments (Fig. 18, ele. 1812; para. 94), a target allocation of the at least one investor account among the plurality of investments (Fig. 18, ele. 1812; para. 94), and the designated goal (Fig. 19, ele. 1928), wherein the target allocation is an allocation of the at least one investor account among the plurality of investments chosen by the user (Figs. 8, 10, 12; paras. 86-91) .

See also Summary and Background of the Invention.

Given that Applicant's specification and drawings show that the risk profile allocation and target allocation are identical (See Fig. 14 of instant application), both are read as the target allocation ("Suggested Holdings", Fig. 18 of *Peters*). This is a logical understanding, as one would want the target allocation to be a reflection of the allocation resulting from the users specified risk tolerance; one would want a target to reflect the desired risk.

Regarding Claim 42, *Maggioncalda* further discloses data input and analysis with respect to an investment marketplace at Abstract and Col. 7, line 8 to Col. 8, line 3, and allocation of funds based on recited parameters at Fig. 8 and Col. 13, line 9 to Col. 14, line 47.

Concerning Claim 45, *Maggioncalda* discloses goals of education of a child and purchasing a home at Col. 13, lines 52-55.

Regarding Claim 46, *Maggioncalda* discloses a warning at Col. 13, lines 9-42 and Fig. 7c.

Regarding Claim 47, *Maggioncalda* discloses the invention substantially as claimed. See the discussion of Claim 1. *Maggioncalda* does not specifically disclose consideration of the recited rates of return and standard deviation. Official Notice is taken that it was old and well known at the time of the invention to consider such information in investment advisory processes. For example, the recited rates were indicators of investments as value or growth investments and standard deviation was an indicator of volatility of an investment. It would have been obvious to one of ordinary skill in the art at the time of the invention to include these considerations in the investment advisory method of *Maggioncalda* because this would make for improved quality of investment advice. See *Maggioncalda* at fig 5a.

With respect to Claim 48, *Maggioncalda* discloses an investment proposal at Fig. 4, eles. 430 and 420.

With respect to Claim 49, *Maggioncalda* discloses a goal-based calculator at Fig. Col. 1, lines 38-48.

Regarding Claim 50, *Maggioncalda* discloses quantification of a goal at Fig. 4, ele. 420, “goal of \$117,849 in retirement at age 65”.

Regarding Claims 62-63, they are method forms of Claims 41 and 42 and are rejected in a like manner.

Regarding Claims 65 and 67, see the discussion of Claims 62 and 45-46.

As to Claim 66, see the discussion of Claims 45 and 62.

Claim 68 is a method form of Claim 47 and is rejected in a like manner.

Regarding Claims 69, see the discussion of Claims 62 and 48.

Regarding Claim 70-71, see the discussion of Claims 62 and 50.

Claims 43-44, 51-61, 64, 72-75 and 77-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,918,217 *Maggioncalda et al* in view of US 2003/0208427 *Peters et al* and further in view of US 6,430,542 *Moran*.

As to Claim 43, *Maggioncalda* discloses the invention substantially as claimed, including outputting via the front-end data indicating recommended potential investments for an investment portfolio associated with a designated goal. See Fig. 4 and related text. See also the discussion of *Maggioncalda* does not specifically disclose that the system recognizes relationships between multiple investors. *Moran* discloses this limitation at Fig. 10 and Col. 12, lines 53-64. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Maggioncalda* to include the recognition of relationships among investors in investments disclosed by *Moran* because this would consider the economic effects of portfolio decisions on related groups rather than disparate individuals. See *Moran* at Col. 12, lines 56-64.

Concerning Claim 44, *Moran* discloses a husband/wife relationship at Col. 12, line 59.

As to **Claim 51**, *Maggioncalda* further discloses a Recommended Purchase screen at Fig. 4, ele. 430. *Moran* discloses an Investor/Goal Manager screen at Fig. 17, an Asset Allocation screen at Fig. 23, a Portfolio Analytics screen at Fig. 12 and a proposal Generation screen at Fig. 45. It would have been obvious to one of ordinary skill in the art at the time of the invention to add the screens disclosed by *Moran* to those of *Maggioncalda* because this would provide fuller functionality for the advisory method of *Maggioncalda*.

With respect to **Claim 52**, see *Moran* at Figs. 10-27. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Maggioncalda* with the creation of investors groups and account addition functions disclosed by *Moran* because this would allow advisors to customize information on investors for the advisory process.

Concerning **Claim 53**, *Moran* discloses consideration of progress to a goal at Col. 2, lines 11-30.

With respect to **Claim 54**, *Maggioncalda* discloses review of mutual funds at Fig. 5a and Col. 10, lines 20-30.

Concerning **Claim 55**, Official Notice is taken that customization of proposals for particular customers by selecting subsets of data was old and well known at the time of the invention. For example, an advisor might wish to provide a greater number of exhibits for the more detail-oriented customer. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Maggioncalda* with this feature to provide proposals most accessible to each customer.

Concerning Claims 56-58, *Maggioncalda* discloses a General Asset Allocation report associated with a designated goal at Figs. 5a, 12a, 12b, 14a and 14b. See also Col. 3, lines 29-60, Col. 8, line 5 to Col. 9, line 62 and Col. 16, lines 26-67.

As to Claim 59, *Maggioncalda* discloses a retirement module at Col. 18, lines 26-38.

Regarding Claim 60, *Moran* discloses an entry port screen having links to navigational icons that trigger associated screens at Fig. 3. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the entry screen of *Moran* in the method of *Maggioncalda* because this would provide a logical point to begin the advisory process and give access to successor functions.

With respect to Claim 61, *Moran* discloses successor options at Fig. 2, lines 77-79.

Regarding Claim 64, it is the method form of Claim 43 and is rejected in a like manner.

Concerning Claims 72-73, see the discussion of Claims 70 and 51.

Regarding Claims 74-75 and 77-79, see the discussion of the respective Claims from which they depend and Claims 53-55 and 57-58.

Claim 80 is a method form of Claim 60 and is rejected in a like manner.

Claim 81 is a method form of Claim 61 and is rejected in a like manner.

Response to Arguments

Applicant's arguments with respect to claims 41-81 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (571) 272-6746. The examiner can normally be reached on 6:30 to 3:00.

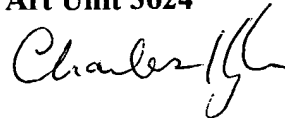
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Crk
December 14, 2005

Primary Examiner
Charles Kyle
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A handwritten signature in black ink, appearing to read "Charles Kyle", with a stylized flourish at the end.